Remarks

1. Summary of the office action

In the office action mailed May 12, 2009, (i) the Examiner rejected claims 56-65 and 69 under 35 U.S.C. § 112, first paragraph, (ii) the Examiner rejected claims 56-65 and 69 under 35 U.S.C. § 112, second paragraph, (iii) the Examiner rejected claims 43-53, 55-65, and 67 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0109310 (Heaton), (iv) the Examiner rejected claims 54, 66, 68, and 69 under 35 U.S.C. § 103(a) as being unpatentable over Heaton in view of U.S. Patent Application Publication No. 2004/0005919 (Walker), and (v) the Examiner stated that claims 43-55 and 68 have 35 U.S.C. § 101 issues regarding high tech printed matter.

2. Amendments and status of the claims

Applicant has amended claims 43 and 56. Now pending in this application are claims 43-69. Of the pending claims, claims 43 and 56 are independent.

3. Response to the claim rejections under 35 U.S.C. § 112, first paragraph

The Examiner rejected claims 56-65 and 69 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Regarding claim 56, the Examiner stated that the limitation of "at a menu system including a categorization device" was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has amended claim 56 to recite, *inter alia*, (i) a method of operating a menu system so as to display data corresponding to a number of available casino games playable by a player at an online casino, the menu system including a **categorization facility** and a display

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device, and (ii) the **categorization facility** categorizing the available casino games into a plurality of different selectable game categories. Applicant has deleted the phrase "categorization device" from claim 56.

The specification clearly provides support for a menu system including a categorization facility and a display device. *See*, e.g., page 9, line 27, and page 10, line 34. Additionally, the specification clearly provides support for the claimed functionality carried out by the categorization facility. *See*, e.g., page 9, line 27, to page 10, line 2, and page 10, lines 32-36. Applicant submits that a person having ordinary skill in the art would understand that the inventor, at the time the application was filed, had possession of the invention recited in claim 56, as amended. Therefore, Applicant submits that claim 56, as amended, complies with the written description requirement.

With regard to the rejection of claims 57-65 and 69 under 35 U.S.C. § 112, first paragraph, the Examiner did not list any claim limitations that caused the claims not to comply with the written description requirement except for the limitation "at a menu system including a categorization device," which is recited in claim 56 and incorporated by reference into claims 57-65, and 69. Applicant believes that claims 57-65 and 69 comply with the written description requirement. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 56-65 and 69 under 35 U.S.C. § 112, first paragraph.

4. Response to the claim rejections under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 56-65 and 69 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claims the subject matter which Applicant regards as the invention. Regarding claim 56, the Examiner stated the preamble of "At a menu system including a categorization device and a display device, a method of operating

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the menu system so as to display" is indefinite as to whether claim 56 is a system claim or a method claim. The Examiner stated that rewriting the preamble as "A method of operating the menu system, including a categorization device and a display device, so as to display" would clarify that the claim pertains to a method.

Applicant has amended the preamble of claim 56 to recite "A method of operating a menu system so as to display data corresponding to a number of available casino games playable by a player at an online casino, the menu system including a categorization facility and a display device, the method comprising." Applicant submits that the preamble currently recited in claim 56 clarifies that claim 56, as well as claims 57-65 and 69, pertains to a method. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 55-65 and 69 under 35 U.S.C. § 112, second paragraph.

5. Response to the claim rejections under 35 U.S.C. § 102

The Examiner rejected claims 43-53, 55-65, and 67 under 35 U.S.C. § 102(e) as being anticipated by Heaton. Under M.P.E.P. § 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Applicant submits that Heaton does not anticipate claims 43-53, 55-65, and 67, because Heaton does not disclose or suggest each and every element recited in these claims.

a. Claims 43 and 56

Of claims 43-53, 55-65, and 67, claims 43 and 56 are independent. At a minimum, Heaton does not disclose or suggest **the display device displaying to the player, simultaneously: an identity of each one of the plurality of different game categories, and at least one attribute of each game in a selected one of the plurality of different game**

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categories, wherein multiple games are categorized into the selected one of the plurality of different game categories, as recited in claims 43 and 56.

The Examiner cited to paragraph 33, lines 9-11, and Figure 3 for teaching these elements of claims 43 and 56, and the Examiner stated that item 302 of Figure 3 is a list of casino games, some of which are table games and the other is a slot type, and Figure 3 discloses a name of a game. Furthermore, on page 8 of the office action, the Examiner stated Heaton teaches an identity of the casino games, some of which are table games and the other is a slot type (see Fig. 3, 302 through 314), and Heaton teaches at least one attribute, being the game names (see Fig. 3, 304 through 314).

Applicant respectfully submits that the Examiner has erred in equating items 302 through 314 in Figure 3 of Heaton as both an identity of each one of a plurality of different **game categories**, and as at least one **attribute of each game** in a selected one of the plurality of different game categories.

First, even if it is assumed, for the sake of argument, that Heaton discloses items 302 through 314 amount to different **game categories**, it does not logically follow that items 302 through 314 are also **an attribute of each game** in a selected one of the plurality of different game categories, as alleged by the Examiner. Moreover, even if it is assumed, for the sake of argument, that some other portion of display 300 in Figure 3 of Heaton amounts to an attribute of a game, as far as Applicant can tell, such attribute would pertain to only a single game (i.e., blackjack). *See*, Heaton, paragraph 0034. Thus, even if it is assumed, for the sake of argument, that items 302 through 314 of Heaton amount to different game categories, since Heaton at best only discloses displaying attributes of one game when items 302 through 314 are displayed, Applicant submits that Heaton does not disclose or suggest **the display device displaying to the**

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player, simultaneously: an identity of each one of the plurality of different game categories, and at least one attribute of each game in a selected one of the plurality of different game categories, wherein multiple games are categorized into the selected one of the plurality of different game categories, as recited in claims 43 and 56.

Next, even if it is assumed, for the sake of argument, that Heaton discloses that items 302 through item 314 amount to **at least one attribute of each game** in a selected one of the plurality of different game categories, it does not logically follow that items 302 through 314 are also **an identity of each one of the plurality of different game categories**.

According to Heaton, display 300 may include menu bar 302, and in some embodiments, menu bar 302 may be divided into games, options, or any other suitable categories. *See*, Heaton, paragraph 0045. Even if it is assumed for the sake of argument that (i) games 302 of Heaton amounts to a game category, and (ii) items 304-314 amount to **at least one attribute of each game in a selected one of the plurality of different game categories, Applicant submits that Heaton does not disclose or suggest the display device displaying to the player, simultaneously an identity of each one of the plurality of different game categories**, as recited in claims 43 and 56.

Applicant submits that the "options" item of display 300 does not amount to a games category, for at least the reason that multiple games are not categorized into the "options" item. Additionally, Heaton does not disclose or suggest that any of the "other suitable categories" is a games category in which multiple games are categorized into, and thus the other suitable categories disclosed by Heaton also do not amount to the selected one of the plurality of game categories. Applicant further submits that no other portion of display 300 amounts to a games category and thus Heaton does not disclose or suggest **the display device displaying to the**

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player, simultaneously: an identity of each one of the plurality of different game categories, and at least one attribute of each game in a selected one of the plurality of different game categories, wherein multiple games are categorized into the selected one of the plurality of different game categories, as recited in claims 43 and 56.

Because Heaton does not disclose or suggest each and every element of claims 43 and 56, Heaton fails to anticipate claims 43 and 56. Applicant submits that claims 43 and 56 are therefore in condition for allowance.

b. Claims 46 and 59

Claim 46 depends on claim 45, and both of these claims ultimately depend on claim 43. Claim 59 depends on claim 58, and both of these claims ultimately depend on claim 56. Claims 46 and 59 both recite, *inter alia*, the game status is an active status when the selected game is ready for playing by the player, and an inactive status when the selected game is not ready for playing by the player.

According to claim 45, **the additional game attributes displayed** for any selected one of the games in the selected game category **includes** any one or more of a size of a jackpot that can be won on the selected game, a plurality of different parameters of the selected game, a graphical representation of a display of the selected game, and **a game status**. According to claim 58, **the display device displaying the additional game attributes** for any selected one of the games in the selected game category **includes displaying** any one or more of a size of a jackpot that can be won on the selected game, a plurality of different parameters of the selected game, a graphical representation of a display of the selected game, and **a game status**. Thus, the game status recited in claims 46 and 59 are displayable game attributes.

In rejecting claims **46**, 47, **59**, and 60, the Examiner cited to Heaton, Figure 1

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and paragraphs 0034 and 0035. These portions of Heaton disclose a system including a server 116. Even if it is assumed, for the sake of argument, that these portions of Heaton disclose subject matter claimed in claims 47 and 60, Applicant submits that these portions of Heaton, alone or in combination with the other portions of Heaton, do not disclose or suggest that a displayable game status is an active status when the selected game is ready for playing by the player, and an inactive status when the selected game is not ready for playing by the player, as recited in claims 46 and 59.

Because Heaton does not disclose or suggest each and every element of claims 46 and 59, Heaton fails to anticipate claims 46 and 59. Applicant submits that claims 46 and 59 are therefore in condition for allowance.

c. Claim 44, 45, 47-53, 55, 57, 58, 60-65, and 67

Without conceding any assertions made by the Examiner regarding dependent claims 44, 45, 47-53, 55, 57, 58, 60-65, and 67, Applicant submits that claims 44, 45, 47-53, 55, 57, 58, 60-65, and 67 are allowable for at least the reason that each of these claims depends from one of allowable claims 43 and 56.

6. Response to claim rejections under 35 U.S.C. § 103

The Examiner rejected claims 54, 66, 68, and 69 under 35 U.S.C. § 103(a) as being obvious over Heaton and Walker. As set forth in 35 U.S.C. § 112, fourth paragraph, a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers. Since claims 54, 66, 68, and 69 depend ultimately from one of claims 43 and 56, claims 54, 66, 68, and 69 are to be construed to incorporate by reference all the limitations of one of claims 43 and 56.

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As stated above, Heaton does not disclose or suggest **the display device displaying to the player, simultaneously: an identity of each one of the plurality of different game categories, and at least one attribute of each game in a selected one of the plurality of different game categories, wherein multiple games are categorized into the selected one of the plurality of different game categories**, as recited in claims 43 and 56. Applicant submits that Walker does not make up for this deficiency of Heaton.

Since Heaton and Walker do not reasonably lead to each and every limitation incorporated by reference into claims 54, 66, 68, and 69, without conceding the Examiner's assertions regarding claims 54, 66, 68, and 69, Applicant submits that Heaton and Walker do not render claims 54, 66, 68, and 69 obvious under 35 U.S.C. § 103(a). Therefore, Applicant submits that claims 54, 66, 68, and 69 are in condition for allowance.

7. Response to the Examiner's comments regarding 35 U.S.C. § 101

On page 8 of the office action, the Examiner stated that claims 43-55 and 68 have 35 U.S.C. § 101 issues regarding high tech printed matter, and that data structures not claimed as embodied in computer-readable media are descriptive *per se* and are not statutory because they are not capable of causing functional change in the computer.

Claim 43, as amended, now recites a menu system that includes; a computer workstation that stores a computer-executable program; and a display device, wherein execution of the computer-executable program by the computer workstation causes the display device to display game data corresponding to a number of available casino games playable by a player at an online casino, the number of available casino games being categorized into a plurality of different selectable game categories characterized in that the display device displays to the player, simultaneously: a) an identity of each one of the plurality of different game categories; b) at least one attribute of each game in a selected one of the plurality of different game categories,

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wherein multiple games are categorized into the selected one of the plurality of different game categories; and c) additional game attributes of any selected one of the games in the selected game category. Applicant submits that claim 43, as amended, and dependent claims 44-55 and 68 recite subject matter in compliance with 35 U.S.C. § 101.

8. Conclusion

Applicant believes that all of the pending claims have been addressed in this response. Failure to address a specific rejection or assertion made by the Examiner does not signify that Applicant agrees with or concedes that rejection or assertion.

For the foregoing reasons, Applicant submits that claims 43-69 are in condition for allowance. Therefore, Applicant respectfully requests favorable reconsideration and allowance of all of the claims.

Respectfully submitted,

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